

REMARKS

Disposition of Claims

Claims 1, 3, 5-8, 10-12, 14, 16, 17 and 19-20 were pending in the application. Claims 1, 3, 5-8, 10-12, 14, 16, 17 and 19-20 were rejected. No Claims were allowed.

By way of this amendment, the applicant has amended claim 18. Additionally, claim 7 has been canceled. Claims 1, 3, 5-6, 10-12, 14, 16, 17 and 19-20 remain unchanged.

Accordingly, Claims 1, 3, 5-6, 8, 10-12, 14, 16, 17 and 19-20 remain pending in the application and stand ready for further action on the merits.

Rejections To Claims Under 35 U.S.C. §112

Claims 7 and 19 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The applicant has canceled Claim 7 and has corrected the dependency in Claim 19. Withdrawal of this rejection is respectfully requested.

Rejections Under 35 U.S.C. §103

The present Office Action has rejected claims 1, 3, 6-8, 11, 12, 14, 17 and 19 under 35 U.S.C. §103(a) as being unpatentable over US Patent No. 1,068,621 (Abraham) in view of US Patent No 214,105 (Cole). The Examiner has stated that Abraham discloses a picture frame including a front surface, a rear surface and aperture in the front surface defining a display area for receiving and displaying a picture, a storage compartment received adjacent the rear surface of the picture frame, said storage compartment having an aperture and a closure element for covering and closing the aperture. The Examiner further stated that while Abraham the storage compartment being slidably removable from the picture frame or nor the use of receiver rails for installing the storage compartment onto the rear of the picture frame, Bulka teaches a slidably received storage compartment and Cole teaches the use of mounting channels and that it would be obvious to a person of ordinary skill in the art to combine these references in order to produce present invention.

The Examiner has identified element 13 in the Abraham reference as a closure element. Further, the Examiner states that element 13 in Abraham binds photo sheets and close off the opening in the storage compartment. The Examiner has simply dismissed the disclosure of Abraham in applying this rejection. Element 13 is clearly indicated as, "a card border that is formed of heavy cardboard of canton flannel to

present a smooth and yieldable surface." This card border is configured to receive and support a single picture. Subsequently, a plurality of card borders, supporting a plurality of pictures, is then stacked together and the stack is placed into the compartment wherein the front picture in the stack is displayed through the glass in the picture frame. They are not bound to one another and a single closure element/binder rail does not support a plurality of pictures. A simple reading of the Abraham disclosure at Page 1, lines 80-104 clearly describes exactly this arrangement. Further, element 13 is not a closure element because clearly the purpose as stated within the Abraham reference itself is to allow a user to freely withdraw any one of the pictures within the plurality by sliding it out and move it to the front of the stack so that it is displayed through the display window. If a single card border 13 were used in the Abraham device, then only a small fraction of the aperture would be closed. The balance of the aperture would remain open. It is not until a plurality of card borders 13 (5 as depicted in Fig 3.) is stacked together and inserted into the storage compartment that the aperture is closed. Therefore, element 13 itself is not a closure element, but a plurality of element 13s stacked onto one another eventually fills the aperture eventually closing it off.

The claims of the present invention as amended clearly can be contrasted with the invention in the Abraham patent. The present invention is formed to provide a storage compartment that is adapted for use with any conventional picture frame. In the broadest claims of the present invention, the storage compartment is just that. It may be used for holding items other than pictures. For example, the compartment may hold shells that were collected during a walk on the beach during a vacation. This is why the Applicant chose in claim 1 to claim a storage compartment and a closure element. The Abraham invention simply does not function as is provided in Claim 1 of the present invention because, without a stack of border frames 13 and cards 12 the compartment remains open ended. If a plurality is stacked and inserted, the storage compartment is full and unavailable for storage of items.

The Applicant then chose in a dependent claim to state that the storage compartment is meant to receive a sleeve of pictures wherein the entire sleeve is bound into a single storage album by the binder rail. The sleeve of pictures including the binder rail is inserted into an aperture in the side of the storage compartment and the binder rail serves to close the aperture in the storage compartment providing a neat and finished appearance. This allows a user to store a group of pictures that are generally related to the picture in the display position within the frame in a convenient and accessible

location for future viewing. This is clearly different from the device in Abraham wherein each of the pictures is mounted separately onto individual pieces of cardboard where the user can switch any of the pictures into a display position. There is no disclosure related to a binder rail wherein the binder rail holds a sleeve of pictures and also serves to close the aperture in the storage compartment.

Cole was cited as disclosing a storage box that slides onto the rear of a picture frame using mounting channels formed in the sides of the picture frame. However, the storage box does not have any aperture provided for accessing the storage box once installed with the picture frame. The only means for accessing the contents of the box however is by disturbing the entire assembly and removing the picture frame from the box. This simply does not meet the claimed limitations of the present invention wherein the storage box has an aperture making it accessible for picture storage without disrupting the entire assembly.

Even if the Cole reference were relied upon only for the disclosure of a storage compartment mounted to a frame using rails, the Abraham disclosure is still lacking in several critical claimed elements. Accordingly, even if the disclosed inventions of Abraham and Cole were combined, the resulting device would be lacking in a closure element for the storage compartment and a binder rail for binding several pictures into a single package wherein the binder rail itself serves as the closure element. Since none of the cited references, Abraham and/or Cole disclose the features of the present invention, either alone or in combination, they cannot render the present invention obvious.

In summary, the Applicant believes that the Examiner has oversimplified the determination of obviousness in combining the cited references. The Applicant notes that "care must be taken to avoid hindsight reconstruction by using the patent in suit as a guide through the maze of prior references, combining the right reference in the right way so as to achieve the result of the claims in suit." Grain Processing Corp. v. American Maize-Products Corp., 5 USPQ2d 1788 (Fed. Circ. 1988). The Applicant submits that the Examiner has used improper hindsight in reconstructing the invention. To give a skilled artisan the two cited references alone, without also giving him the particular problem to be solved, i.e. the problem of providing a universal storage compartment that can be accessed without removing the compartment from the frame itself would not provide any motivation to combine the features to result in the claimed invention.

While clearly one could assemble virtually any known device from a combination of prior devices by simply picking and choosing the appropriate constituent elements from prior art references, the standard of law requires that the references provide some basic teaching or suggestion that would motivate the combination. There is simply nothing explicit or implicit in Abraham or Cole that would motivate someone skilled in the art to replace the elements as cited by the Examiner without first having knowledge of the Applicant's intended device. The combination would simply not be obvious from a reading of only the cited references. The wholesale and random replacement of elements without motivation or teaching is clearly improper under the law.

Specifically, the present invention includes a storage compartment with an aperture in the side thereof with a closure element that closes the compartment or alternatively a picture binder rail that holds a sleeve of a plurality of pictures in a single group and also serves as a closure for the aperture. This combination of features simply is not shown or described in any of the cited references. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Rejections Under 35 U.S.C. §103

The present Office Action has rejected claims 5, 10, 16 and 20 under 35 U.S.C. §103(a) as being unpatentable over US Patent No. 1,068,621 (Abraham) in view of US Patent No 214,105 (Cole) and in further view of US Patent 6,868,630 (Kim). The Examiner has stated that while Abraham and Cole do not teach the use of magnets, Kim provides such disclosure and that the present invention is obvious in view of a combination of these references.

However, as stated above, the present invention includes a storage compartment with an aperture in the side thereof with a closure element that closes the compartment or alternatively a picture binder rail that holds a sleeve of a plurality of pictures in a single group and also serves as a closure for the aperture. Even if the disclosed inventions of Abraham and Cole were combined, the resulting device would be lacking in a closure element for the storage compartment and a binder rail for binding several pictures into a single package wherein the binder rail itself serves as the closure element.

The simple addition of Kim for disclosure relating to magnets does not overcome the above noted lack of disclosure with respect to the base invention as claimed.

Accordingly, since this combination of features simply is not shown or described in any of the cited references, Applicant respectfully requests that this rejection be withdrawn.

Conclusion

In summary, Applicant submits that claims 1, 3, 5-6, 8, 10-12, 14, 16, 17 and 19-20 are patentable and each of the Examiner's rejections and objections has been overcome. Accordingly, Applicants respectfully request favorable consideration and allowance of amended claims 1, 3, 5-6, 8, 10-12, 14, 16, 17 and 19-20.

The Commissioner is hereby authorized to charge any additional fee required in connection with the filing of this paper or credit any overpayment to Deposit Account 02-0900.

Should there be any outstanding matter that needs to be resolved in the present application, the Examiner is invited to contact the undersigned at the telephone number provided below.

Respectfully submitted,
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